

associated expression pattern sufficient for use as a diagnostic marker, the skilled artisan would understand that fragments of SEQ ID NO: 107, as well as polynucleotides sharing structural identity with SEQ ID NO: 107, as set forth in claims 67-71, can be made and used in detecting expression of SEQ ID NO: 107, and thus in the detection of prostate cancer according to Applicants' disclosure. However, as set forth above, and without prejudice to prosecution of this subject matter in a related application, Applicants have cancelled claims 67-71 at this time in order to advance prosecution of the subject application. Reconsideration and withdrawal of this rejection under 35 U.S.C. § 112, first paragraph, is thus respectfully requested.

***Rejection Under 35 U.S.C. § 112, First Paragraph (written description)***

Claims 65-71 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that Applicants, at the time the application was filed, had possession of the claimed invention.

Applicants respectfully traverse this rejection. As discussed with Examiner Souaya during the telephonic interview conducted February 25, 2003, the skilled artisan, in view of the instant specification, would understand that Applicants were in possession of the claimed isolated fragments of SEQ ID NO: 107, as well as polynucleotides sharing structural identity with SEQ ID NO: 107, on the basis that such polynucleotides can be used to detect expression of SEQ ID NO: 107, and thus detect the presence of prostate cancer according to Applicants' disclosure. However, as set forth above, and without prejudice to prosecution of this subject matter in a related application, Applicants have cancelled claims 67-71 at this time in order to advance prosecution of the subject application. Reconsideration and withdrawal of this rejection under 35 U.S.C. § 112, first paragraph, is thus respectfully requested.

***Rejection Under 35 U.S.C. § 112, Second Paragraph***

Claims 65 and 66 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly containing subject matter that is indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. More particularly, the Examiner asserts that claims 65 and 66 are indefinite as it allegedly cannot be determined if the claims encompass a fragment of SEQ ID NO: 107, which comprises at least 75 or 150 consecutive nucleotide residues of SEQ ID NO: 107, or to a polynucleotide comprising a

fragment of SEQ ID NO: 107 which comprises 75 or 150 consecutive nucleotide residues of SEQ ID NO: 107.

As an initial matter, Applicants note that claim 67 has been canceled, without prejudice. Accordingly, the Examiner's rejection of claim 67 under 35 U.S.C. § 112, second paragraph, is now moot.

Applicants respectfully traverse the rejection of claims 65 and 66 on the basis that the metes and bounds of the claimed invention would be clear and unambiguous to the artisan of ordinary skill. The claims are drawn to isolated polynucleotides comprising SEQ ID NO: 107, or to fragments thereof comprising at least 75 (claim 65) or 150 (claim 66) consecutive nucleotide residues of SEQ ID NO: 107. Thus, the claims encompass fragments of SEQ ID NO: 107, comprising at least 75 or 150 consecutive nucleotide residues, and, furthermore, encompass polynucleotides, e.g., recombinant vectors, comprising the recited fragments of SEQ ID NO: 107. Applicants note that fragments of SEQ ID NO: 107, in a multitude of illustrative embodiment, are indeed extensively described in the specification as originally filed, e.g., page 36, lines 20-29. Reconsideration of this rejection is thus respectfully requested.

#### ***Double Patenting Rejections***

Claims 64-71 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 10 of U.S. Patent No. 6,262,245. According to the Examiner, although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the '245 patent is drawn to an isolated DNA molecule comprising the sequence of SEQ ID NO: 107 and claim 10 is drawn to polynucleotides that encode the polypeptide encoded by SEQ ID NO: 107.

Without acquiescing to the grounds for this rejection, Applicants submit herewith a timely filed Terminal Disclaimer over U.S. Patent No. 6,262,245. Reconsideration and withdrawal of this rejection is respectfully requested.

Claims 64-72 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 3-4 of copending Application Nos. 09/895,814; 09/780,669; and 09/759,143. According to the Examiner, although the conflicting claims are not identical, they are not patentably distinct from each other.

With regard to Application No. 09/895,814 (Applicant Ref. 427C26), no

Restriction Requirement has been received to date. Accordingly, Applicants respectfully request that this provisional rejection be held in abeyance until such time that allowable subject matter is identified in the instant application and/or until a group/species election is made in Application No. 09/895,814.

With regard to Application No. 09/780,669 (Applicant Ref. 427C24), no Restriction Requirement has been received to date. Accordingly, Applicants respectfully request that this provisional rejection be held in abeyance until such time that allowable subject matter is identified in the instant application and/or until a group/species election is made in Application No. 09/780,669.

With regard to Application No. 09/759,143 (Applicant Ref. 427C23), Applicants recently elected Group I, claims 1, 3-4, and 11, and the species of SEQ ID NO:110, for examination, which sequence is unrelated to the prostate cancer sequence of SEQ ID NO: 107 that is currently under examination in the instant application. A Preliminary Amendment effecting removal of reference to SEQ ID NO: 107 and cancellation of non-elected claims of Application 09/759,143 will be filed in due course, a copy of which will be provided at the time allowable subject matter is identified in the instant application.

Claims 64-72 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4-10, 16 and 58-60 of copending Application Nos. 09/636,215; 09/593,793; 09/605,783; and 09/568,100. According to the Examiner, although the conflicting claims are not identical, they are not patentably distinct from each other.

Applicants respectfully traverse this rejection on the basis that the subject matter elected and under examination in Application Nos. 09/636,215; 09/593,793; 09/605,783; and 09/568,100 is unrelated to the subject matter of the instant claims.

With regard to Application No. 09/636,215 (Applicant Ref. 427C17), Applicants elected Group I, claims 4-8, 16 and 58-60, and SEQ ID NO:110 for examination, which sequence is unrelated to the prostate cancer sequence of SEQ ID NO: 107 that is currently under examination in the instant application. Claims 4-10, 16 and 58-60 are no longer pending in Application No. 09/636,215. Applicants' amendment effecting cancellation of claims 4-10, 16

and 58-60 of Application No. 09/636,215 was filed December 2, 2002, a copy of which will be provided at the Examiner's request.

With regard to Application No. 09/593,793 (Applicant Ref. 427C15), Applicants elected Group VI (claims 18-20, 22, 25-31), and the species of SEQ ID NO: 113 for examination, which sequence is unrelated to the prostate cancer sequence of SEQ ID NO: 107 that is currently under examination in the instant application. Claims 4-10, 16 and 58-60 are no longer pending in Application No. 09/593,793. Applicants' amendment effecting cancellation of claims 4-10, 16 and 58-60 of Application No. 09/593,793 was filed July 18, 2002, a copy of which will be provided at the Examiner's request.

With regard to Application No. 09/605,783 (Applicant Ref. 427C16), Applicants elected Group VII, claims 35-37, and SEQ ID NO:113 for examination, which sequence is unrelated to the prostate cancer sequence of SEQ ID NO: 107 that is currently under examination in the instant application. An amendment effecting removal of reference to SEQ ID NO: 107 and cancellation of non-elected claims of Application No. 09/605,783 will be filed in due course, a copy of which will be provided at the time allowable subject matter is identified in the instant application.

With regard to Application No. 09/568,100 (Applicant Ref. 427C13), Applicants elected Group I, claims 1-3, 14-17, 64 and 65, and SEQ ID NO:113, which sequence is unrelated to the prostate cancer sequence of SEQ ID NO: 108 that is currently under examination in the instant application. An amendment effecting removal of reference to SEQ ID NO: 107 and cancellation of non-elected claims of Application 09/568,100 will be filed in due course, a copy of which will be provided at the time allowable subject matter is identified in the instant application.

The Commissioner is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment to our Deposit Account No. 19-1090.


Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "**Version With Markings to Show Changes Made.**"

All of the claims remaining in the application are now believed to be in condition for allowance. Favorable consideration and a Notice of Allowance are earnestly solicited.

Respectfully submitted,

Jiangchun Xu et al.

Seed Intellectual Property Law Group PLLC

  
for Jeffrey Hundley, Ph.D., Patent Agent  
Registration No. 42,676

JEH:tt

Enclosure:

Postcard  
Terminal Disclaimer  
Statement Under 37 CFR 3.73(b)

701 Fifth Avenue, Suite 6300  
Seattle, Washington 98104-7092  
Phone: (206) 622-4900  
Fax: (206) 682-6031  
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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims:

Claims 67-71 have been canceled.

Claim 72 has been amended, as follows:

72. (Amended) An isolated polynucleotide comprising a complete complement of a polynucleotide according to any one of claims ~~64-71~~ 64-66.

New claims 73 and 74 have been added, as follows:

73. (New ) A recombinant vector comprising a polynucleotide according to any one of claims 64-66.

74. (New) A host cell comprising a recombinant vector according to claim 73.